

## **Section II. (REMARKS)**

The pending claims in the application are claims 1, 3-5, 7, 8, and 28.

### **Amendment to claims 1 and 28**

Claims 1 and 12 have been amended to excise formic acid, **without prejudice**. Claim 28 has been amended to include the limitations of previously pending claim 29, with the exception of formic acid, **without prejudice**. As such, no new matter has been cited herein and no new search is necessitated.

Claim 32, which was previously withdrawn by the Examiner, has been amended to depend from claim 28 for rejoinder purposes.

Claims 6, 19 and 29 have been **without prejudice**.

### **Election/Restrictions**

In the December 5, 2007 Office Action, the Examiner withdrew claim 32 from consideration as being directed to a non-elected invention. Applicants acknowledge same and request reconsideration of said claim upon allowance of the claim from which said withdrawn claim 32 depends.

In addition, applicants previously requested rejoinder of method claims 12, 14-19 and 21-27 upon allowance of the composition claims 1, 3-5, 7 and 8. Towards that end, withdrawn method claim 12 has been amended in a manner consistent with the pending composition claims.

### **Rejection of Claims and Traversal Thereof**

In the December 5, 2007 Office Action:

claim 6 was rejected under 35 U.S.C. §112, second paragraph;

claims 1, 3-8, 28 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Cotte et al. (U.S. Patent Application Publication No. 20050224748) or alternatively as being anticipated by Cotte et al. (U.S. Patent No. 6,838,015);

claims 1,3-8 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Krasutsky et al. (U.S. Patent Application Publication No. 20050158414);

claims 1, 3-8, 28 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Granick et al. (U.S. Patent Application Publication No. 20040214002); and

claims 1, 3-8, 28 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Biberger et al. (U.S. Patent Application Publication No. 20020001929).

These rejections are traversed and reconsideration of the patentability of the pending claims is requested in light of the following remarks.

**Rejection under 35 U.S.C. 112, second paragraph**

In the December 5, 2007 Office Action, claim 6 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 has been cancelled, without prejudice, thereby obviating this rejection. Withdrawal of same is respectfully requested.

**Rejections under 35 U.S.C. §102**

1. In the December 5, 2007 Office Action, claims 1, 3-8, 28 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Cotte et al. (U.S. Patent Application Publication No. 20050224748) (hereinafter Cotte '748) or alternatively as being anticipated by Cotte et al. (U.S. Patent No. 6,838,015) (hereinafter Cotte '015). Cotte '748 corresponds to the divisional application of Cotte '015 therefore both have the same specification and reference will hereinafter be made generally to "Cotte." Applicants traverse said rejection.

According to the Examiner, Cotte teaches a method of removing polish using a composition of supercritical CO<sub>2</sub> and organic acids such as formic acid.

Applicants have removed formic acid from claim 1, without prejudice, thereby obviating this rejection. In addition, applicants have amended claim 28 to include the limitations of claim 29, with the exception of

formic acid, without prejudice, thereby obviating this rejection. Withdrawal of the rejection of claims 1, 3-8, 28 and 29 as being anticipated by Cotte is respectfully requested.

2. In the December 5, 2007 Office Action, claims 1,3-8 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Krasutsky et al. (U.S. Patent Application Publication No. 20050158414) (hereinafter Krasutsky). Applicants traverse such rejection.

According to the Examiner, Krasutsky teaches a method of extracting plant materials using carbon dioxide, formic acid and isopropyl alcohol.

As introduced hereinabove, claim 1 has been amended to excise formic acid, without prejudice, thereby obviating this objection, and claim 29 has been cancelled. Withdrawal of the rejection of claims 1, 3-8, and 29 as being anticipated by Krasutsky is respectfully requested.

3. In the December 5, 2007 Office Action, claims 1, 3-8, 28 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Granick et al. (U.S. Patent Application Publication No. 20040214002) (hereinafter Granick). Applicants traverse such rejection.

According to the Examiner, Granick teaches a suitable solvent for dissolving polymers including supercritical carbon dioxide, formic acid and various co-solvents.

Contrary to the Examiner's contention, Granick does not disclose, expressly or inherently, formic acid as one of the possible solvents. Furthermore, as admitted by the Examiner, Granick teaches a suitable solvent for dissolving polymers. In other words, the "composition" that the Examiner refers to in the December 5, 2007 Office Action is actually the solvent portion of a solution including at least one polymer solute.

It is well established as a matter of law that the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931). Granick teaches a composition including at least one polymer dissolved in a solvent (see, Granick, paragraph [0027]) and as such, does not anticipate applicants' claim 1 which is closed to including a polymer species.

Withdrawal of the rejection of claims 1, 3-8, 28 and 29 as being anticipated by Granick is respectfully requested.

4. In the December 5, 2007 Office Action, claims 1, 3-8, 28 and 29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Biberger et al. (U.S. Patent Application Publication No. 20020001929) (hereinafter Biberger). Applicants traverse such rejection.

According to the Examiner, Biberger teaches a supercritical pre-clean composition containing CO<sub>2</sub>, various ketone co-solvents, and formic acid.

As introduced hereinabove, claim 1 has been amended to excise formic acid, without prejudice, and claim 28 has been amended to include the limitations of claim 29, with the exception of formic acid, without prejudice, thereby obviating this objection. Withdrawal of the rejection of claims 1, 3-8, 28 and 29 as being anticipated by Biberger is respectfully requested.

#### **The November 29, 2006 Office Action**

During a review of the file, it came to the attention of the undersigned representative that there were two (2) different Office Actions prepared having a mailing date of November 29, 2006. After careful review, it is noted that one was prepared by the Examiner on November 21, 2006, while the second was prepared by the Examiner on January 17, 2007 (see, the bottom of the Office Action Summary sheet). To reiterate, both the Office Action prepared on November 21, 2006 and the Office Action prepared on January 17, 2007 had a mailing date of November 29, 2006.

The latter prepared Office Action (the one with the January 17, 2007 date on the Office Action Summary sheet) was the last entry in the paper file and was responded to on February 28, 2007. The earlier Office Action (the one with the November 21, 2006 date on the Office Action Summary sheet) was just discovered. The undersigned notes that one reference, Cotte '875 was referred to in both Office Actions. The remaining references, Fischer et al. (U.S. Patent No. 5,043,280) (hereinafter Fischer) and Fulton et al. (U.S. Patent No. 6,756,084) (hereinafter Fulton), will be discussed herein to complete the record.

According to the Examiner, "concerning the reducing agents, specifically the hydrogen and the formic acid, Fischer teaches the inclusion of these two compounds in the supercritical gas" and "Fischer further teaches the inclusion of isopropyl alcohol." That said, the Fischer compositions also require "a substance

or substances” and “a carrier or carriers.” Examples of carriers include polymer materials and examples of substances include medicines, toxins, pesticides, insecticides, herbicides, viruses and diagnostic materials.

Fulton teaches methods for depositing particles on a substrate using supercritical fluids, wherein said substances to be deposited include polymers, non-polymeric organic materials, non-polymeric inorganic materials, and combinations thereof.

As a reminder, claim 1 recites:

**“A SCF-based removal composition consisting of at least one supercritical fluid (SCF), at least one co-solvent, and at least one reducing agent, wherein the at least one reducing agent consists of at least one of hydrogen gas, formaldehyde, formalin, boranes, diboranes, amine stabilized boranes, amine stabilized alanes, and tetraalkyl amines of  $BH_3$  and  $AlH_3$ , and wherein the at least one SCF consists of a fluid selected from the group consisting of carbon dioxide, oxygen, argon, krypton, and xenon.”** (emphasis added)

In other words, claim 1 is closed to the inclusion of Fischer’s substances and carriers and Fulton’s substances. Accordingly, claim 1 as pending, and the claims depending therefrom, is not anticipated by either Fischer or Fulton.

The undersigned apologizes for the inadvertent error in not recognizing that there were two different Office Actions with exactly the same mailing date.

#### **Petition for Extension of Time/Fees Payable**

Applicants hereby petition for a two (2) month extension of time, extending the deadline for filing the response to the December 5, 2007 Office Action from March 5, 2008 to May 5, 2008.

The fee of \$460.00 specified in 37 CFR §1.17(a)(2) for the two (2) month extension is being paid by Electronic Funds Transfer. Authorization is hereby given to charge any deficiency in applicable fees for this response to Deposit Account No. 13-4365 of Moore & Van Allen PLLC.

#### **Conclusion**

Based on the foregoing, claims 1, 3-5, 7, 8, 28 and 29 are in form and condition for allowance. Authorization is hereby given to charge any deficiency in applicable fees for this response to Deposit Account No. 13-4365 of Moore & Van Allen PLLC. If any additional issues remain, the Examiner is requested to contact the undersigned attorney at (919) 286.8090 to discuss same.

Respectfully submitted



Date: May 5, 2008

By: \_\_\_\_\_

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